



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of)	Examiner: C. A. Marmor II
Lubock et al.)	
For: DILATION DEVICES AND METHODS FOR)	Group Art Unit: 3736
REMOVING TISSUE SPECIMENS)	
Serial No.: 09/916,937)	
Filed: July 21, 2001)	
Atty. Docket No.: R0367-02600)	

EXPRESS MAIL LABEL NO. ER 492868983 US
Mailed in San Francisco, CA on September 29, 2004

**PETITION TO WITHDRAW HOLDING OF ABANDONMENT
(MPEP 711.03(c) II and 37 CFR §1.181)**

Mail Stop: Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

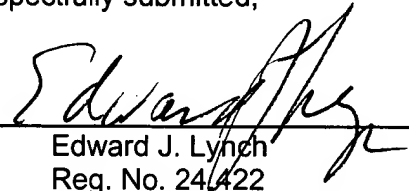
Applicant herein received a Notice of Abandonment mailed September 14, 2004 in the above-identified application for failure to timely pay the required issue fee and publication fee within the statutory period of three months from the mailing date of the Notice of Allowance. A copy of that Notice is enclosed herewith. In lieu of paying the issue and publication fees, Applicants filed via facsimile on July 21, 2004 the Request For Continued Examination Under 37 CFR §1.114 (RCE). Other papers concurrently enclosed therewith for filing were the Petition To Withdraw Claim Of Priority Under 37 CFR §1.182 And Request For Corrected Filing Receipt Thereof, Preliminary Amendment And Information Disclosure Statement; form PTO-1449 and copies of 2 cited references. Applicants enclose herewith a copy of the RCE as filed on July 21, 2004 in its entirety, along with the corresponding copy of the facsimile transmission report as evidence of proof of certificate of mailing as set forth in 37 CFR §1.8(b). Although incomplete in its reporting, the Patent Application Information Retrieval (PAIR) indicates that an amendment was received by the Patent Office on July 21, 2004. A print copy of the relevant PAIR is enclosed herewith.

Applicants have at no time had the intention of abandoning this application. Applicants respectfully petition to withdraw the holding of abandonment.

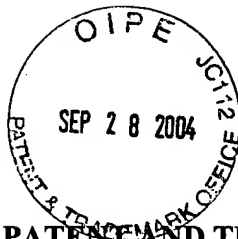
Applicants believe themselves not to be in error; however, the Commissioner is authorized to charge any deficiency in fees or overpayment of fees required under 37 C.F.R. §1.16 or §1.17 to Deposit Account 04-1679, referencing Atty. Docket No. R0367-02600.

Respectfully submitted,

By: _____


Edward J. Lynch
Reg. No. 24422
Attorney for Applicants

Duane Morris LLP
One Market
Spear Tower, Ste. 2000
San Francisco, CA 94105
Phone: (415) 371-2200
Fax: (415) 371-2201
Direct Dial: (415) 371-2267



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of
Lubbock et al.

) Examiner: C. A. Marmor II
)
) Group Art Unit: 3736

For: DILATION DEVICES AND
METHODS FOR REMOVING
TISSUE SPECIMENS

Serial No.: 09/916,137

Filed: July 27, 2001

Atty. Docket No.: R0367-02600

**REQUEST FOR CONTINUED
EXAMINATION UNDER 37 CFR §1.114**

CERTIFICATE OF MAILING/FACSIMILE PURSUANT TO 37 C.F.R. §1.8

I hereby certify that this these papers are being sent by facsimile to (703) 872-9306 addressed to Examiner Charles A. Marmor II,
at Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on July 21, 2004, in San Francisco, CA.

By: [Signature]

Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is a request for continued examination (RCE) under 37 C.F.R. § 1.114 of the above-identified application.

1. **Submission required under 37 C.F.R. § 1.114**

a. ☐ Previously submitted

i. ☐ Consider the amendment(s)/reply under 37 C.F.R. § 1.116 previously filed on _____ (any unentered amendment(s) referred to above will be entered).

ii. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on _____.

iii. ☐ Other: _____.

b. ☒ Enclosed

i. ☒ Amendment/Reply

ii. ☐ Affidavit(s)/Declaration(s)

iii. ☒ Information Disclosure Statement (IDS)

iv. ☐ Other:

2. **Fees due**

/ X / Request For Continued Examination, \$385.

/ X / Petition, \$130.

Total Fees Due, \$515.

3. **Payment of Fees**

/ X / The Commissioner is hereby authorized to charge any fees and to credit any overpayment of fees which may be required under 37 CFR §1.16 and §1.17, to Deposit Account No. 04-1679, referencing Atty. Docket No. R0367-02600. A duplicate of this sheet is enclosed for this purpose.

4. **Address all future communications to:**

Edward J. Lynch
DUANE MORRIS LLP
One Market
Spear Tower, Suite 2000
San Francisco, CA 94105

5. **Other documents enclosed herewith:**

/ X / Petition To Withdraw Claim Of Priority Under 37 CFR §1.182 And Request For Corrected Filing Receipt Thereof.

/ X / Form PTO-1449 and copies of 2 cited references.

Respectfully submitted,

By: 

Edward J. Lynch
Registration No. 24,422
Attorney for Applicants

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One Market
Spear Tower, Ste. 2000
San Francisco, CA 94105
Telephone: (415) 371-2200
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09/30/00

PATENT

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P

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of) Examiner: C. A. Marmor II
Lubock et al.)
)
For: **DILATION DEVICES AND METHODS**)
FOR REMOVING TISSUE SPECIMENS)
)
Serial No.: 09/916,937) **TRANSMITTAL**
)
Filed: July 21, 2002)
)
Atty. Docket No.: R0367-02600)

EXPRESS MAIL LABEL NO. ER 492868983 US
Mailed in San Francisco, CA on September 29, 2004

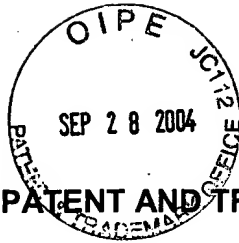
Mail Stop ISSUE FEE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

1. Transmitted herewith for filing in the above-identified patent application are
 - X Petition To Withdraw Holding Of Abandonment (MPEP 711.03(c)ii and 37 C.F.R. §1.181);
 - X Print copy of PAIR;
 - X Copy of RCE as filed on July 21, 2004 in its entirety including
 - X Copy of Petition To Withdraw Claim Of Priority Under 37 CFR §1.182 And Request For Corrected Filing Receipt Thereof
 - X Copy of Preliminary Amendment And Information Disclosure Statement
 - X Copy of Form PTO-1449 and copies of 2 cited references
 - X Copy of facsimile transmission report of July 21, 2004 filing;
 - X Copy of Notice of Abandonment mailed September 14, 2004; and
 - X Self-stamped return receipt postcard.
2. Payment of Fees
 - X Applicant believes that there is no fee due with this communication; however, the Commissioner is authorized to charge any fees and to credit any overpayment of fees which may be required under 37 C.F.R. §1.16 or §1.17, to Deposit Account No 04-1679, referencing Atty. Docket No. R0367-02600. **A duplicate copy of this sheet is enclosed herewith for this purpose.**

By: Edward J. Lynch
Edward J. Lynch
Registration No. 24,422
Attorney for Applicants

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San Francisco, CA 94105
Direct Dial: (415) 371-2267
Facsimile: (415) 371-2201
Phone: (415) 371-2200



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of
Lubock et al.

For: **DILATION DEVICES AND METHODS
FOR REMOVING TISSUE SPECIMENS**

Serial No.: 09/916,937

Filed: July 21, 2001

Atty. Docket No.: R0367-02600

) Examiner: C. A. Marmor, II

) Group Art Unit: 3736

) **PRELIMINARY AMENDMENT AND**
) **INFORMATION DISCLOSURE**
) **STATEMENT**

CERTIFICATE OF MAILING PURSUANT TO 37 C.F.R. §1.8

I hereby certify that this correspondence is being transmitted by facsimile to Examiner C. A. Marmor II (703) 872-9306, Mail Stop RCE,
Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on July 21, 2004 in San Francisco, CA.

By: *mt*

Via Facsimile

Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

For further consideration pursuant to the concurrently filed Request For
Continued Examination, please preliminarily amend the above identified application as
follows:

SPECIFICATION AMENDMENTS

On page 1 after the title of this application, please delete the following:

~~CROSS-REFERENCE TO RELATED APPLICATIONS~~

Please delete paragraph [0001] as follow:

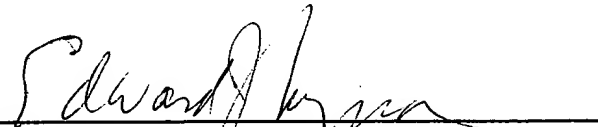
~~[0001] — The present invention is a continuation-in-part of United States Patent Applications Serial Nos. 09/057,303 for "Breast Biopsy System and Method," filed on April 8, 1998, 09/146,185 for "Methods and Apparatus for Securing Medical Instruments to Desired Locations in a patient's Body," filed on September 1, 1998, 09/159,467 for "Electrosurgical Biopsy Device and Method," filed on September 23, 1998, 09/238,965 "Tissue Specimen Destruction Device and Method Thereof," filed on January 27, 1999, 09/356,187 for "Electrosurgical Lesion Location Device," filed on July 16, 1999, and 09/477,255 for "Apparatus and Method for Accessing a Biopsy Site," filed on January 4, 2000, all assigned to the assignee of the subject application, which are each hereby incorporated by reference in their entirety, and from each of which priority is claimed under 35 U.S.C. 120.~~

REMARK

Information Disclosure Statement

Applicants wish to bring to the attention of the Patent Office the references listed on the attached PTO-1449 form and request that they be considered by the Examiner.

Respectfully submitted,

By: 
Edward J. Lynch
Registration No. 24,422
Attorney for Applicants

DUANE MORRIS LLP
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San Francisco, CA 94105
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Facsimile: (415) 371-2201
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<p align="center">IN THE UNITED STATES PATENT AND TRADEMARK OFFICE</p> <p align="center">INFORMATION DISCLOSURE STATEMENT</p> <p align="center">UNDER 37 CFR §1.56, §1.97, and §1.98</p> <p align="center">PTO-1449 FORM</p> <p align="center">SHEET 1 OF 1</p>	<p>ATTORNEY DOCKET NO.:</p> <p align="center">R0367-02600</p>	<p>SERIAL NO.:</p> <p align="center">09/916,937</p>
<p align="center">SEP 28 2004</p>	<p>APPLICANT:</p> <p align="center">Lubock et al.</p>	<p>EXAMINER</p> <p align="center">C. A. Marmor, II</p>
	<p>FILING DATE:</p> <p align="center">July 21, 2001</p>	<p>GROUP ART UNIT:</p> <p align="center">3736</p>

U.S. PATENT DOCUMENTS

† EX'R INITIAL	*REF. #	PATENT NUMBER	DATE (MO/YR)	NAME	U.S. CLASS/ SUBCLASS	FILING DATE (If appropriate)
	A152	6,135,997	10/00	Laufer et al.		
	A153	6,280,450	8/01	McGuckin, Jr.		

FOREIGN PATENT DOCUMENTS

† EX'R INITIAL	*REF. #	PATENT NUMBER	DATE (MO/YR)	COUNTRY	TRANSLATION (YES/NO)	

OTHER DOCUMENTS

† EX'R INITIAL	*REF. #	Document Description (including Author, Title, Date, Pertinent Pages, Etc.)

EXAMINER'S SIGNATURE	DATE CONSIDERED
----------------------	-----------------

† EXAMINER: Initial if reference is considered, whether or not citation is in conformance with MPEP 609.
Line through citation if not in conformance and not considered.
Include copy of this form in next communication to applicant.

* If an asterisk is placed beside the reference number, a copy is not provided because the reference was previously cited by or submitted to the PTO in a prior application that is identified in the statement and relied upon for an earlier filing date under 35 U.S.C. 120. 37 C.F.R. 1.98(d).



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09/916,937

DILATION DEVICES AND METHODS FOR REMOVING TISSUE

Application Data	Transaction History	Image File Wrapper	Patent Term Adjustments	Continuity Data	Published Documents	Publication Date
Date	Contents Description					
09-14-2004	Mail Abandonment for Failure to Pay Issue					
09-14-2004	Abandonment for Failure to Pay Issue Fee					
05-13-2004	Correction - Drawing NOT Required					
04-07-2004	Workflow - Request for RCE - Finish					
07-21-2004	Workflow incoming amendment IFW					
07-19-2004	Receipt into Pubs					
06-16-2004	Receipt into Pubs					
06-11-2004	Workflow - File Sent to Contractor					
05-13-2004	Mail Notice of Allowance					
05-12-2004	Notice of Allowance Data Verification Complete					
05-12-2004	Notice of Allowability					
04-07-2004	Workflow - Request for RCE - Begin					
04-27-2004	IFW TSS Processing by Tech Center Complete					
04-27-2004	Date Forwarded to Examiner					
04-27-2004	Date Forwarded to Examiner					
04-07-2004	Request for Continued Examination (RCE)					
04-27-2004	Express Abandonment (for Entry of CPA / I)					
01-14-2004	Mail Final Rejection (PTOL - 326)					
01-12-2004	Final Rejection					
10-28-2003	Date Forwarded to Examiner					
09-04-2003	Response after Non-Final Action					
06-04-2003	Mail Non-Final Rejection					
06-02-2003	Non-Final Rejection					
03-25-2003	Date Forwarded to Examiner					
03-17-2003	Response to Election / Restriction Filed					
02-25-2003	Mail Restriction Requirement					



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02-24-2003	Requirement for Restriction / Election
01-29-2003	Information Disclosure Statement (IDS) File
09-09-2002	Case Docketed to Examiner in GAU
03-28-2002	Information Disclosure Statement (IDS) File
03-14-2002	Case Docketed to Examiner in GAU
03-06-2002	Application Dispatched from OIPE
02-25-2002	Application Is Now Complete
01-07-2002	Additional Application Filing Fees
01-07-2002	A statement by one or more inventors satis under 35 USC 115, Oath of the Applic
01-07-2002	Applicant has submitted new drawings to c problems
02-25-2002	Correspondence Address Change
08-17-2001	Notice Mailed--Application Incomplete--Fili
08-16-2001	Correspondence Address Change
08-06-2001	IFW Scan & PACR Auto Security Review
07-27-2001	Initial Exam Team nn

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*** TX REPORT ***



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DUANE MORRIS LLP
ONE MARKET, SPEAR TOWER, SUITE 2000
SAN FRANCISCO, CA 94105-1104
PHONE: 415.371.2200
FAX: 415.371.2201

FACSIMILE TRANSMITTAL SHEET

TO: Mail Stop RCE, Examiner C. A. Marmor, II

FIRM/COMPANY: Commissioner for Patents

FACSIMILE NUMBER: (703) 872-9306

CONFIRMATION
TELEPHONE: (703) 305-3521
FROM: Ruth Der

DIRECT DIAL: 415.371.2231

DATE: July 21, 2004

USER NUMBER:

FILE NUMBER: Atty Docket No. R0367-02600, Serial No. 09/916,937

TOTAL # OF PAGES: 54
(INCLUDING COVERSHEET)

MESSAGE: Attached are *Petition To Withdraw Claim Of Priority Under 37 CFR 1.182 And Request For Corrected Filing Receipt Thereof; RCE; Preliminary Amendment And IDS/form PTO-1449* and copies of 2 cited references.

Please confirm receipt of this transmission.



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of
Lubock et al.

) Examiner: C. A. Marmor, II

) Group Art Unit: 3736

For: **DILATION DEVICES AND METHODS
FOR REMOVING TISSUE SPECIMENS**

Serial No.: 09/916,937

Filed: July 21, 2001

Atty. Docket No.: R0367-02600

CERTIFICATE OF MAILING PURSUANT TO 37 C.F.R. §1.8

I hereby certify that this correspondence is being transmitted by facsimile to Examiner C. A. Marmor II (703) 872-9306, Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on July 21, 2004, in San Francisco, CA.

By: [Signature]

**PETITION TO WITHDRAW CLAIM OF PRIORITY UNDER 37 C.F.R. §1.182 AND
REQUEST FOR CORRECTED FILING RECEIPT THEREOF**

Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants hereby petition under 37 C.F.R. §1.182 to withdraw all claim of priority in the above-referenced application in view of the allowed claims in this application.

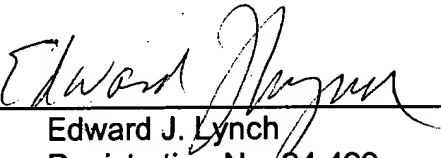
Applicants withdraw the claim of priority to applications U.S. Serial No. 09/057,303, filed April 8, 1998, now U.S. Pat. No. 6,331,166, Serial No. 09/146,185, filed September 1, 1998, now U.S. Pat. No. 6,540,693, Serial No. 09/159, 467, filed September 23, 1998, now U.S. Pat. No. 6,261,241, Serial No. 09/238,965, filed January 27, 1999, now U.S. Pat. No. 6,659,105, Serial No. 09/356,187, filed July 16, 1999, now U.S. Pat. No. 6,312,429, and Serial No. 09/477,255, filed January 4, 2000, now U.S. Pat. No.

6,471,700. Additionally, Applicants request a new corrected filing receipt reflecting the withdrawal of claim of priority.

The fee under 37 C.F.R. §1.17(h) for this petition of \$130.00 should be charged to Deposit Account 04-1679, referencing Atty. Docket No. R0367-02600. The Commissioner is authorized to charge the same deposit account any deficiencies in fees in connection with this petition. A duplicate copy of this paper is enclosed for this purpose.

Please note that concurrently filed herewith is a Request for Continued Examination Under 37 C.F.R. §1.114.

Respectfully submitted,

By: 
Edward J. Lynch
Registration No. 24,422
Attorney for Applicants

DUANE MORRIS LLP
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UNITED STATES PATENT AND TRADEMARK OFFICE

20367-02400

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,937	07/27/2001	Edward J. Lynch DUANE MORRIS LLP ONE MARKET SPEAR TOWER, SUITE 2000 San Francisco, CA 94105	26684-1250	9292

7590 09/14/2004

RECEIVED

SEP 23 2004

DUANE MORRIS

EXAMINER

MARMOR II, CHARLES ALAN

ART UNIT PAPER NUMBER

3736

DATE MAILED: 09/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Docketed

SEP 23 2004

By JB

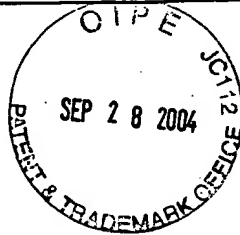


UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

PUBLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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09/19/937



EXAMINER

ART UNIT	PAPER NUMBER
----------	--------------

DATE MAILED:

NOTICE OF ABANDONMENT

This application is abandoned in view of:

- ☐ Applicant's failure to timely file a proper reply to the Office letter mailed on _____.
- ☐ A reply (with Certificate of Mailing or Transmission of _____) was received on _____ which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
- ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
- ☐ A reply was received on _____, but it does not constitute a proper reply, or a *bona fide* attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in the last box below).
- ☐ No reply has been received.
- ☒ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
- ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85)(or Notice of Publication Fee Due).
- ☐ The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee by 37 CFR 1.18 is \$_____. The publication fee, if required, by 37 CFR 1.18(d) is \$_____.
- ☒ The issue fee and publication fee, if applicable, have not been received.
- ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTOL-37).
- ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
- ☐ No corrected drawings have been received.
- ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all the applicants.
- ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon filing of a continuing application.
- ☐ The decision by the Board of Patent Appeals and Interferences rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
- ☐ The reason(s) below: _____
Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

LD